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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,584	01/05/2004	Bernd Sundermann	785-011641-US(C01)	3103
7590 Clarence A. Green 425 Post Road Fairfield, CT 06824			EXAMINER CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/28/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/751,584	<b>Applicant(s)</b> SUNDERMANN ET AL.	
	<b>Examiner</b> Celia Chang	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-13, 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This application is a continuation of PCT/EP02/07379. A claim to priority benefit was made but cannot be granted since copy of priority document or its certified translation were not made of record.

2. Applicant's election without traverse of Group I, X is CH<sub>2</sub> compounds in the reply filed on Dec. 18, 2006 is acknowledged.

Claims 14-23 have been canceled. Claims 1-6, 8-13, 24 and newly added claims 7, 25-36 are pending.

Please note that claim 26 is missing. Therefore, newly added claims 27-36 have been renumbered as claims 26-35 per 37 CFR 1.126.

It was clearly delineated in the restriction requirement that if the non-statutory "use" claim were to be amended to a method of use format, the method claims can only be rejoined if they are dependent from only the allowable product and free of all 112 issues. It is noted that the only descriptive support for the newly added method claims 25-36 is found on pages 21-23, 31-33 being analgesic test by writhing test in mice, claims 26-27 (renumbered from 27-28) are rejoined. Claims 24, 28-35 (renumbered from 29-36) being drawn to the non-elected process of treatment claims are withdrawn from consideration.

Claims 1-13, 25-27 are prosecuted.

3. Claim 2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Please note that in applicants' remark, it was noted that claim 2 was canceled but the claim set presented with the election did not cancel claim 2. Cancellation is recommended.

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4. Claim 7 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Please note that claim 7 is dependent on a later numbered claim 8. Claim 8 is drawn to process for which the subject matter of claim 7 being a compound lacks antecedent basis.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-13, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuny et al. US 6,677,332 in view of Yamamoto et al. US 6,642,257.

Both Cuny '332 and Yamamoto '247 are drawn to piperidinyll compounds having activity in combating pain, i.e. analogous art.

Determination of the scope and content of the prior art (MPEP §2141.01)

Cuny et al. '332 disclosed structural analogous compounds having pain treating/analgesic activity (see col. 14-16, formula A, col. 113-114 table 7) and a structurally analogous species with good activity was exemplified at col. 1-7, example 71.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between this exemplified compound 71 of the prior art and the instant claims i.e. the species of claim 25, especially, the 11<sup>th</sup> compound, is that instead of the side chain -CHR<sup>3</sup>XNR<sup>1</sup>R<sup>2</sup>, being attached at the 4-position, the prior art compound has the attachment at 3-position of the central piperidinyll ring. The analogous art by Yamamoto et al. '257 disclosed 4-attachment piperidinyll compound having similar structure and showed that the compounds have good analgesic activity (col. 66-76 Table 6 and col. 32 table 4).

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*Finding of prima facie obviousness—rational and motivation (MPEP§2142-2143)*

One having ordinary skill in the art is deemed to be aware of all the pertinent art in the field. The above references places the structurally analogous substituted piperidineyl analgesic compounds in the possession of artisan in the field. One skilled in the art would be motivated to modify the compounds of Cuny et al. ;332 with a position isomerism **because** position isomerism has been well recognized in the pharmaceutical art being prima facie structural obvious. Especially, the instant modification was made from a proven compound with attributes of other proven compounds with position isomerism which is prima facie obvious. In re Dillon 16 USPQ2d 1897, 1911; In re Mehta 146 USPQ 284.

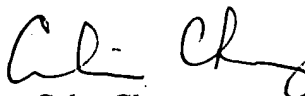
6. No claim is allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang  
Feb. 26, 2007

  
Celia Chang  
Primary Examiner  
Art Unit 1625